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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/276,716	03/26/1999	MASATOSHI YOKOTA	0020-4539P	2499

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-19

Office Action Summary

Application No.

09/276,716

Applicant(s)

YOKOTA, MASATOSHI

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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Claims 1 and 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1's "with the range of 5" is unclear.

Claims 1 and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Moriyama '802 Patent in view of Tanaka '663.

Moriyama '802 exemplifies (#1-3) three layer balls having a soft outer cover and a hard inner cover. The core has a deformation of 3.7 to 5.0 (col. 3, line 5).

Moriyama does not measure his core's JIS-C hardness or uniformity thereof. Applicant (paper # 14, table 1) has shown the core has a JIS-C surface hardness of 75. However, according to applicant's declaration this hardness is not uniform throughout the core.

It is known that cores with uniform hardness improves ball properties (col.3, lines 5-7 of Tanaka) and typically are within the JIS-C range claimed by applicant.

It would have been obvious to ensure Moriyama's core hardness is uniform for the expected advantages.

Claims 1 and 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Moriyama '856 Patent in view of Sullivan '356.

Moriyama discloses golf balls having the same core used by applicant (examples 1-3). Moriyama's core can have two covers (col. 4, lines 24-29). Moriyama does not provide details of the dual cover.

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Dual covered balls having a hard, highly filled inner cover and soft outer cover are known to be advantageous (see Sullivan's abstract, claim 33, col. 41, lines 48-54, col. 32, lines 9,26).

It would have been obvious to ensure Moriyama's dual cover has the shore D and density characteristics taught by Sullivan for the expected advantages.

Applicant's arguments filed 9/17/02 have been fully considered but they are not persuasive.

The declaration shows Moriyama '802's example does not have the required hardness uniformity in the core.

Applicant argues Tanaka '663 lack the cover hardness requirements of the current claims.

Of course Tanaka lacks the cover hardness. The reference would have been applied as anticipatory if the cover hardness teachings are present. Tanaka is relied on for his teachings regarding the core. The primary reference (Moriyama '802) has the required covers. Attacking the references individually does not show unobviousness (MPEP 2145 (iv)):

Applicant argues the combination of Moriyama '802/Tanaka '663 does not account for the superior properties exhibited by the claimed ball.

Tanaka explains maintaining the core within certain deformation limits and hardness uniformity provides good shot feel, durability and rebound (col. 2, lines 62-67; col. 3, lines 4-6). Applicant's superior properties are not unexpected. The rejection need not show all of applicant's advantages anyway (MPEP 2145 II "Arguing additional Advantages").

Applicant argues the Moriyama '856 in view of Sullivan rejection fails to recognize the superior properties is the claimed ball.

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Moriyama '856 (col. 3, lines 50-56) recognizes that uniform core hardness is important for hit feeling. Sullivan (col. 7, lines 8-19) explains the prior art has already recognized a hard inner cover improves COR (for distance) and the soft outer cover provides advantageous feel. Applicant's superior properties are not unexpected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/mn
December 2, 2002

David Buttner